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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,861	11/01/2000	James Russell Miller	BostonBrace/Belt	5592

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LUCASH, GESMER & UPDEGROVE, LLP  
40 BROAD ST  
SUITE 300  
BOSTON, MA 02109

EXAMINER

PHAM, HUONG Q

ART UNIT

PAPER NUMBER

3764

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/705,861

Applicant(s)

MILLER, JAMES RUSSELL

Examiner

Huong Q. Pham

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 31-35, 37-44, 47-51, 53-60, and 62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-35, 37-44, 47-51, 53-60, and 62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

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## DETAILED ACTION

Claims 31- 35, 37-44 are objected to because of the following reason: in claim 31, " the first back element" lacks proper antecedent basis ( note that " the first back element" mentioned in the preamble of the claim is not positively recited ). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 31-34, 37, 40, 47-50, 53, 57, and 62 are rejected under 35 U.S.C. 102(e) as being anticipated by Morrow. As for claim 31, Morrow shows every claimed feature of

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claim 31 including an elongated strips 12,14 made of rigid material, locking elements 24, 18, 26, a center portion including means 36 ( Figure 2) for fastening the belt to a first back element 20, 34. As for claims 32 and 40, note the inner pad 40 of Morrow. As for claims 33 and 34, note Figure 1 of Morrow. As for claim 37, note that the belt of Morrow is made of plastic material. As for claim 47, note that the back shell 20 of Morrow " having an inner surface shaped to fit about a person 's lower back region" . As for claims 48-50, 53, 57 and 62, note the comments relative to claims 31-34, 37, 40 above.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrow in view of Richards et al. Richards et al teaches a cooperating hook and loop fastening element for a belt. In view of the teaching of Richards et al, it would have been obvious to an ordinary skill in the art at the time the invention was made to substitute the locking mechanism of Morrow with the cooperating hook and loop fastening of Richards et al to permit precise adjustment . Note that the use of cooperating hook and loop fastening is very well-known in the art, and the substitution

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of one element for another well-known structure in the art is only a matter of obvious engineering design choice.

Claims 38, 39, 54-56, 59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrow in view of Modglin. While Morrow discloses that his belt is made of a rigid plastic that possesses some flexibility, Modglin teaches a brace made of polyethylene, a low density plastic. In view of the teaching of Modglin, it would have been obvious to an ordinary skill in the art at the time the invention was made to use this type of plastic for the brace of Morrow. Note that the use of polyethylene plastic for braces is very well-known in the art.

Claims 41-44 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrow in view of Valazquez. While Morrow is not specific about his fastening elements 36, Valazquez teaches the use of screws and rivets for fastening a pelvic belt to a back support. In view of the teaching of Valazquez, it would have been obvious to an ordinary skill in the art at the time the invention was made to substitute the fastening elements 36 of Morrow with screws or rivets to provide the ability of removing or non-removing the belt from a back support. Note that the use of screws or rivets for fastening elements of a brace together is very well-known in the art.

Applicant's arguments filed on 6/11/03 have been fully considered but they are not persuasive. Applicant argues that " independent claim 31.....does not recite or

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claim that the center portion of the elongated strip includes a molded depression as taught by Morrow", and " ....does not recite or claim any type of packet....." , etc....

Note that the claims need to particularly point out and distinctly or positively claim the subject matter or structure(s) which applicant regards as applicant's invention, because the claims are being examined based on the structures recited in the claims, not based on the structures not being recited by the claims. Note that claims 31 and 47 positively recite structures or elements disclosed by Morrow, and all the structures or elements made up the belt of applicant's, as recited in claims 31 and 47, are disclosed by Morrow.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

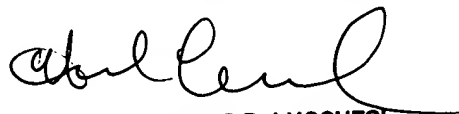
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (703) 305-5129. The examiner can normally be reached on 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on (703) 308 - 2698. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

  
NICHOLAS D. LUCCHESI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

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